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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/186,064 11/04/98 TOOMBS

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EXAMINER

MYERS, P

ART UNIT

PAPER NUMBER

2181

DATE MAILED:

05/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/186,064

Applicant(s)

TOOMBS ET AL.

Examiner

Paul R. Myers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2001.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1-27 have been considered but are moot in view of the new ground(s) of rejection.

In regards to applicants argument that the Iijima reference teaches the host telling the memory card which protocol to use, and does not teach the newly added claim limitation of the memory card selecting the communication protocol: The examiner agrees therefor the Iijima reference will be converted from a 102 reference to a 103 reference. Official notice is taken that it is very well known for a device to select the communication protocol based upon the communication protocol of another device to which it is to communicate. This is commonly done for backwards compatibility. The examiner cites PN 5,790,796, PN 5,081,667, PN 5,875,415, and PN 5,892,824 all of which teach this very well known feature.

In regards to applicants argument that Iijima tests protocols A and B to test which the host responds. This argument indicates the applicants argument that Iijima does not teach selecting the protocol without the host telling it which protocol to use is incorrect. However since this feature is so extremely well known as to make arguing about it a waste of time the examiner is willing to concede applicant first argument that the Iijima does not teach this feature as opposed to applicants second argument that Iijama teaches the card testing to see which protocol to use.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the memory card selecting the

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protocol to use must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

***Claim Rejections - 35 USC § 103***

3. Claims 1-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iijima PN 5,349,649.

In regards to claims 1, 11, 23, 28, 39, 41, 51 and 57: Iijima teaches A memory card (1) for connecting to a master (7), comprising: a plurality of storage elements (2,3,40); and an interface (5) for communicating with the master (7), wherein data (data) and commands (command) are transferred between the card (1) and the master (7); wherein said card (1) is capable of adapting to the master running one protocol (Protocol A or Protocol B) from a plurality of protocols (A or B). Iijima teaches the memory card selecting the protocol based upon the masters informing it of which protocol to use. Iijima does not teach the memory card selecting the communication without the master informing it which protocol to use. Official notice is taken that it is very well known for a device to select the communication protocol based upon the communication protocol of another device to which it is to communicate. It would have been obvious for the memory card to select the protocol based upon the detected protocol of the master because this would have provided for backwards compatibility with older masters.

In regards to claims 2-4, 14-16, 26-27, 30, 42-44, 52-53 and 59-60: Iijima teaches handling plural protocols. Iijima does not teach which specific protocols are supported. Official notice is taken that the MultiMediaCard protocol and the Serial Peripheral Interface protocols are well known standard protocols. It would have been obvious to a person of ordinary skill in the

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art at the time of the invention to support these protocols because this would have made Iijima's card compliant to standards.

In regards to claims 5, 8, 9, 17, 20-21, 31, 32, 37, 45-46, 49, 54-56, 61, 63 and 65: Iijima teaches a common bus for transferring command and data. Iijima does not expressly teach the use of a select signal from the master. The serial peripheral interface (SPI) protocol is well known and described above. The SPI protocol includes select (CE), Data-in (SDI), Data-out (SDO) and Clock (SCLK) lines.

In regards to claims 6, 18, 33-34, 36, 47-48, 62 and 64: Iijima teaches not needing a select signal. MultiMediaCard protocol does not require a select.

In regards to claims 7, 19 and 35: Iijima teaches the bus including command, data, and clock lines.

In regards to claims 10, 22, 38 and 50: Iijima teaches the card is a memory storage device.

In regards to claims 12, 24-25, 29, 40 and 58: Iijima teaches the reason for his invention is for connecting with masters that can only communicate in one protocol.

In regards to claim 13: Iijima teaches the adaptation of the card to the master being transparent to the master.

### *Conclusion*

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

PN 5,875,415 to Lieb et al teaches a universal interface that converts between protocols without the host telling it what protocol to use.

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PN 5,081,667 to Drori et al teaches vehicle security system that selects to protocol to communicate to a host telephone with out the host telephone telling it which protocol to use.

PN 5,790,796 to Sadowsky teaches a client device that selects the protocol from among a plurality to communicate with a master device based upon the detected protocol used by the master.


PN 5,892,824 to Beatson et al teaches signature device that connects to a host computer and detects the hosts communications protocol and selects that protocol to communicate with the host.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul R. Myers whose telephone number is 703 305-9656. The examiner can normally be reached on 6:30am to 3:00pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Beausoleil can be reached on 703 305-9713. The fax phone numbers for the organization where this application or proceeding is assigned are 703 308-9051 for regular communications and 703 308-9052 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-3900.

PRM  
April 30, 2001

  
**PAUL R. MYERS**  
**PRIMARY EXAMINER**